

### **Remarks**

By this amendment, claims 30-37 are added to the application. Claims 21-25 and 28-37 are pending in the present application. Reconsideration is requested in view of the following remarks.

#### **I. Objection to Specification**

The specification has been amended to update the status of the prior applications. Thus, withdrawal of this objection is requested.

#### **II. Rejection Over Bergstein**

Claims 21-25 and 28-29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from U.S. Patent No. 2,628,179 to Bergstein (Bergstein). Applicants traverse this rejection and request that it be withdrawn because a *prima facie* case of obviousness has not been established.

Claim 21 recites a method of forming a cutting edge on a dispensing carton comprising, *inter alia*, supplying a roll of tape to an application station, the tape having a polymeric backing coated with an adhesive on one side, and applying a length of the tape to a length of carton board and laminating the tape to the carton board.

In contrast, Bergstein discloses a device for applying metallic strips to carton blanks, rather than a tape comprising a polymeric backing, as recited in claim 21. A primary advantage of forming the cutting edge from a polymeric tape instead of metal strips is that the polymeric material is not as sharp as and is less likely to cause injury to the consumer as metal. See page 2, lines 5-7 of the application. Bergstein fails to recognize that polymeric tape can be a suitable alternative to metal strips and certainly does not appreciate any of the advantages of using such material.

In the rejection of claim 21, the action contends that cutting edges of polymeric material are well known in the art and that it would have been obvious to use polymeric tape in the Bergstein method because “it is obvious to replace one material with another art recognized alternative material.” Applicants disagree with this contention.

When an obviousness rejection is based on the presupposition that the material recited in the claim is an equivalent of the prior art material, the equivalency must be recognized in the

prior art. MPEP § 2144.06, citing *In re Scott*, 323 F.2d 1016, 139 U.S.P.Q. 297 (CCPA 1963) (reversing an obviousness rejection based on equivalent components; holding that the light wood or hardened foam resin core of the prior art does not fairly suggest the use of the claimed paper core). The action fails to cite any evidence that polymeric tape was recognized in the prior art as a suitable alternative to metal for forming cutting edges. The obviousness rejection is not based on any such evidence, and therefore must be withdrawn. Furthermore, the use of polymeric tape to form a cutting edge flies in the face of the conventional wisdom in the prior art of using metal to form cutting edges.

Accordingly, for the foregoing reasons, the method as set out in claim 21 is not rendered obvious by Bergstein and is allowable.

Claims 22-25 and 28-29 depend from claim 21 and are allowable for the reasons given above in support of claim 21 and because each dependent claim sets forth an independently patentable combination of features.

For example, claim 29 further specifies that the tape is applied in registry with predetermined (preformed) adjacent edges of the carton blanks cut from the carton board. In contrast to claim 29, Bergstein, as presently understood, involves applying metal strips to unitary sheets 21, which are subsequently cut lengthwise to form multiple blanks. The sheets 21 can be in the form of unscored sheets (FIG. 10) or blanks A and B joined to each other at their top edges (FIG. 11). None of the cutting edges disclosed in Bergstein is formed by applying metal strips in registry with predetermined (preformed) adjacent edges of carton blanks.

### **III. Rejection Over Marcalus**

Claims 21-25 and 28-29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious from U.S. Patent No. 1,843,429 to Marcalus (Marcalus). Applicants traverse this rejection and request that it be withdrawn because a *prima facie* case of obviousness has not been established.

Unlike claim 21, Marcalus does not teach or suggest the use of a polymeric tape for forming a cutting edge. Instead, Marcalus involves supplying a roll 14 of indurated paper C (or stencil board), applying glue to the paper C as it is dispensed from the roll, pressing the paper against an edge portion of a carton blank, and shearing off the forward end of the material adhered to the blank to form a cutting edge.

The action contends that cutting edges of polymeric material are well known in the art and that it would have been obvious to use polymeric tape in the Marcalus method because “it is obvious to replace one material with another art recognized alternative material.” Applicants disagree with this contention.

As discussed above, in order to rely on an equivalency as the rationale for an obviousness rejection, the equivalency must be recognized in the prior art. MPEP § 2144.06. The action fails to cite any evidence that polymeric tape was recognized in the prior art as a suitable alternative to indurated paper or stencil board for forming cutting edges. The obviousness rejection is not based on any such evidence, and therefore must be withdrawn.

Accordingly, for the foregoing reasons, the method as set out in claim 21 is not rendered obvious by Marcalus and is allowable.

Claims 22-25 and 28-29 depend from claim 21 and are allowable for the reasons given above in support of claim 21 and because each dependent claim sets forth an independently patentable combination of features.

#### **IV. New claims**

New claims 30-37 have been added to the present application and recite additional features not fairly suggested or taught by Bergstein or Marcalus. Support for these claims can be found in the claims as originally filed and in the specification.

New claim 30, for example, further specifies that the roll of tape is preformed with the adhesive coated on one side of the polymeric backing. Thus, as the tape is dispensed from the roll, it can be applied directly to the carton board without any intervening processing steps (see FIG. 2 of the present application). In contrast, Bergstein’s process does not include supplying a preformed roll of tape coated with an adhesive on one side, as recited in claim 30. Instead, in the Bergstein method, adhesive-less metallic strips 28 are dispensed from a roll 29 and pass over a coater 30 that coats the strips with an adhesive (as shown in FIG. 9). The adhesive coated strips 28 are then applied to sheets 21. Because the Bergstein method requires a separate coater 30 for applying an adhesive to the strips 28, Bergstein inherently does not teach or suggest supplying a preformed roll of tape coated with an adhesive on one side.

Likewise, because Marcalus requires the use of separate glue disks 10 for applying glue to the paper C, Marcalus also fails to teach or suggest supplying a preformed roll of tape having an adhesive coating on one side thereof, as recited in claim 30.

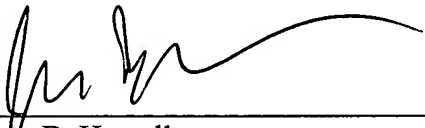
**V. Conclusion**

The present application is in condition for allowance and such action is respectfully requested. If any further issues remain concerning this application, the Examiner is requested to call the undersigned to discuss such matters.

Respectfully submitted,

KLARQUIST SPARKMAN, LLP

By

  
\_\_\_\_\_  
Jeffrey B. Haendler  
Registration No. 43,652

One World Trade Center, Suite 1600  
121 S.W. Salmon Street  
Portland, Oregon 97204  
Telephone: (503) 595-5300  
Facsimile: (503) 228-9446